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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212768
Party	Defendant Disidual Clothing, LLC
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Date	12/20/2013
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

INTS It Is Not The Same, GmbH,

Opposer,

v.

Disidual Clothing, LLC,

Applicant.

Serial No. 85/836,544

Opposition No. 91212768

Mark: DISIDUAL

**DISIDUAL CLOTHING’S MOTION TO STRIKE PLED REGISTRATIONS**

Applicant, Disidual Clothing, LLC (“Disidual Clothing”), by and through its attorneys, Marshall, Gerstein & Borun LLP, requests that the Board strike certain of Opposer, INTS It Is Not The Same, GmbH’s (“INTS”) registrations pled in support of its Notice of Opposition. In support, Disidual Clothing states that:

1. INTS filed its Notice of Opposition on October 2, 2013, asserting likelihood of confusion with its DESIGUAL mark and priority of use.
2. INTS cited five federal registrations for DESIGUAL, in standard characters or stylized, as bases for opposition.
3. In opposing an application for likelihood of confusion, an opposer “must plead (and later prove) priority of use. T.B.M.P. § 309.03(c). *See Media Online Inc. v. El Clasificado Inc.*, 88 U.S.P.Q. 2d 1285, 1287 (T.T.A.B. 2008) (stating that priority is a required element of a likelihood of confusion claim).
4. To assert priority properly in an opposition, an opposer “must allege facts showing proprietary rights in its pleaded mark that are prior to defendant’s rights in the challenged mark.” T.B.M.P. § 309.03(c). Such rights may be established through ownership of

registrations with an underlying application date “prior to any date of first use on which a defendant can rely.” *Id.*

5. Insufficient defenses or other redundant, immaterial, impertinent, or scandalous matter may be stricken from a pleading on the Board’s initiative or on motion. Fed. R. Civ. P. 12(f), T.B.M.P. § 506.01.

6. INTS acknowledged that Disidual Clothing’s application for DISIDUAL claimed a first use in commerce of June 1, 2010. (Not. of Opp. ¶ 6.) The Notice of Opposition does not dispute that June 1, 2010, is a “date of first use on which [Disidual Clothing] can rely.” T.B.M.P. § 309.03(c).

7. Thus, for a registration to be properly pled in support of the claim of priority, its application date must predate Disidual Clothing’s first use claim of June 1, 2010.

8. Among the federal registrations for DESIGUAL, in standard characters or stylized, pled by INTS as bases for opposition for INTS were Reg. Nos. 4113640 and 4269396.

9. As to Reg. No. 4113640, INTS filed its request for extension of protection on May 26, 2011, and claims constructive first use as of that date. (Not. of Opp. ¶ 5.)

10. As to Reg. No. 4269396, INTS applied for registration on October 17, 2011, and claims constructive first use as of that date. (Not. of Opp. ¶ 5.)

11. Such application and constructive first use dates for INTS’s DESIGUAL marks are subsequent to Disidual Clothing’s first use of its DISIDUAL mark, which occurred at least as early as June 1, 2010. (Not. of Opp. ¶ 6.)

12. INTS’s pled Reg. Nos. 4113640 and 4269396 lack priority over Disidual Clothing’s DISIDUAL mark and, therefore, are immaterial or impertinent matter that should be stricken from the Notice of Opposition. Fed. R. Civ. P. 12(f), T.B.M.P. § 506.01.

WHEREFORE, Disidual Clothing asks that the Board strike INTS's aforementioned cited registrations as factually or legally insufficient.

Respectfully submitted,



Dated: December 20, 2013

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### **CERTIFICATE OF FILING**

The undersigned affirms that this ANSWER TO NOTICE OF OPPOSITION was filed with the Trademark Trial and Appeal Board via the ESTTA electronic filing system on the date below.



Dated: December 20, 2013

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Matthew Ciesielski

### **CERTIFICATE OF SERVICE**

The undersigned affirms that this ANSWER TO NOTICE OF OPPOSITION was served by first class mail upon the following:

John S. Egbert  
Egbert Law Offices, PLLC  
1314 Texas, 21st Floor  
Houston, TX 77002



Dated: December 20, 2013

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Matthew Ciesielski